

Application Number 10/629,172  
Responsive to Office Action mailed June 20, 2006

### **REMARKS**

This Response is responsive to the Office Action dated June 20, 2006. Applicant has made no amendments to the claims with this Response. Claims 26-49 are pending.

#### **Claim Rejection Under 35 U.S.C. § 103**

##### ***Claims 26-32, 35-44 and 46-49***

In the Office Action, the Examiner rejected claims 26-32, 35-44 and 46-49 under 35 U.S.C. 103(a) as being unpatentable over Goldman (US 4,811,408). Applicant respectfully traverses the rejection. The applied reference fails to disclose or suggest the inventions defined by Applicant's claims, and provides no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

With reference to independent claims 26 and 38, for example, Goldman lacks any teaching or suggestion of providing a document having an at least partially light-transmissive first layer and a second layer located below the first layer, the second layer including at least one image. As another example, Goldman lacks any teaching or suggestion of comparing a source image with at least one stored image that is stored in a computer, as required by independent claim 26. Similarly, Goldman lacks any teaching or suggestion of comparing a source image with at least one predetermined image that is stored in a computer, as required by independent claim 38.

In the Office Action, the Examiner asserted that Goldman teaches "a method for recovering an image from a document having an image covered by a laminate."<sup>1</sup> Contrary to the Examiner's assertion, the cited portion of Goldman merely states that "the card C (see FIG. 2) has a traditional format and may be formed of plastic, paper laminate, or any of a variety of other sheet materials as well known in the prior art."<sup>2</sup> This passage indicates only that the card as a whole may be formed of any of the enumerated materials. For example, it is very likely that the card C merely comprises an image printed on a plastic card and not an image covered by a laminate. Consequently, Goldman does not address the problem solved by the invention defined

<sup>1</sup> Office Action dated June 20, 2006, at page 2.

<sup>2</sup> Goldman, col. 3, ll. 6-10.

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by Applicant's claims, namely, recovering an image from a document having an at least partially light-transmissive first layer and a second layer located below the first layer, the second layer including at least one image. Instead, Goldman is directed to comparing an image on a card with image data on a magnetic strip of the card.

Goldman provides no teaching or suggestion that the card may be made of an at least partially light-transmissive first layer, and a second layer located below the first layer, the second layer having at least one image. Nor does FIG. 2 of Goldman provide any indication that the card C is made up of more than one layer, let alone an at least partially light-transmissive first layer and a second layer located below the first layer, the second layer including at least one image, as required by independent claims 26 and 38. Goldman therefore fails to teach or suggest this element of Applicant's independent claims and provides no solution to the problem addressed by Applicant's invention.

Furthermore, Goldman also fails to teach or suggest comparing a source image with at least one predetermined image that is stored in a computer, as required by Applicant's claim 38. Goldman describes a card having a picture image and an "escort memory" magnetic strip 14 containing reference data that represents the picture image. FIG. 5 of Goldman makes clear that a card production system scans and digitizes an image already on the card, and representative digital signals that represent that image are recorded on magnetic strip 14 of the card. In operation, the terminal determines the degree to which the image on the card C matches the machine-readable picture reference data recorded on the card, to determine whether the picture image of the card has been tampered with.<sup>3</sup> In particular, Goldman teaches that "the system of the present invention involves sensing the picture image indicia to provide pixel test signals which are compared with pixel reference signals provided from the escort memory."<sup>4</sup>

In contrast, Applicant's invention compares the image of the second layer to a stored or predetermined image stored on a computer, such as an original image from which the image of the second layer was formed. For example, Applicant's claim 38 specifically requires comparing a source image recovered from the second layer with a predetermined image that is stored in a computer. Goldman does not compare the picture image of the card with a predetermined image

<sup>3</sup> Goldman, col. 2, ll. 60-63.

<sup>4</sup> *Id.* col. 3, ll. 24-27 (emphasis added).

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that is stored in a computer. Instead, Goldman stores data that was generated as an approximation of the image on the card, i.e., the pixel reference signals, and then compares the pixel reference signals stored on the card's magnetic strip with pixel test signals obtained from the card image. In no manner does Goldman describe comparing the source image recovered from a second layer with a predetermined image that is stored in a computer, as required by Applicant's claim 38. The pixel reference signals stored in the Goldman card are not a predetermined image, but rather an approximation generated directly from picture on the card. Goldman therefore also fails to teach or suggest this element of Applicant's independent claims.

For at least these reasons, Goldman fails to establish a prima facie case for non-patentability of Applicant's claims 26-32, 35-44 and 46-49 under 35 U.S.C. 103(a).

Withdrawal of this rejection is requested

#### *Claims 33 and 45*

In the Office Action, the Examiner rejected claims 33 and 45 under 35 U.S.C. 103(a) as being unpatentable over Goldman as applied to claim 26 above, and further in view of Hu et al. (US 3,478,658). Applicant respectfully traverses the rejection. The applied references fail to disclose or suggest the inventions defined by Applicant's claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

Claim 4 specifies that the light source for illuminating the image emits polarized light. The Office Action implied that Goldman fail to disclose that the light source emits polarized light, but asserted that incorporation of such a feature would have been obvious in view of Hu et al.

Hu et al. provides no teaching sufficient to overcome the basic deficiencies evident in Goldman as set forth above with respect to the independent claims. In view of the shortcomings of the Goldman reference, it is not necessary to comment in detail on the teachings provided by Hu et al. However, Applicant neither admits nor acquiesces in the propriety of the Examiner's characterizations of Hu et al. or the application of this reference to the claimed invention. Rather, Applicant reserves the right to point out differences between Hu et al. and any aspect of the claimed invention.

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For at least these reasons, Goldman in view of Hu fail to establish a prima facie case for non-patentability of Applicant's claims 33 and 45 under 35 U.S.C. 103(a). Withdrawal of this rejection is requested

### CONCLUSION

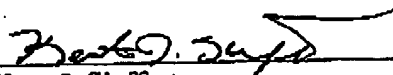
All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

Date:

By:

September 20, 2006

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